



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/665,912	09/20/00	MURATA	M 51270-024 56

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EXAMINER

PSITOS, A

ART UNIT	PAPER NUMBER
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2651

DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/665,912

Applicant(s)

MURATA, MORIHIRO

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations re the ineffective code and effective code as required by claims 4,5,8,9,12,13,16,17,20,21,23,24,26 and 27 as well as the detecting when 5 number of frames as required by claims 22 and 25 must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention, and or failing to particularly point out and distinctly claim the invention.

a) With respect to claims 1 & 28 it is noted that these claims fail to positively recite any detection ability. Such an ability is considered necessary as disclosed and latter included – see claim 6 for

✓ instance, in order for any deletion/erasure to occur – that is if there is no detection of any appropriate frame as disclosed, there can not occur any subsequent “logical erasure”.

b) With respect to claims 6 and 18; it is noted that this claim fails to positively recite the detection

✓ of what frame – note it is the detection of the first frame as disclosed and subsequently claimed –

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see claim 10 for instance – that permits any of the subsequent steps to occur. Absent such a detection, there is no disclosure to permit any of the subsequent steps to occur.

c) With respect to claim 22, it is noted that the detecting of the five number of frames although recited, their disclosed location – as disclosed and subsequently claimed – see claim 23 – is not found in the claim. Hence the examiner concludes that the claim at the very least is misdescriptive in that it fails to particularly point out and distinctly claim the invention. No associated disclosure is found to permit other than a detection of these frames in the preceding section. If such can be found, the examiner would not maintain such a position.

d) With respect to claims 4,5,8, 9,12,13, 16,17,20,21,23,24,26,and 27 all recite either an "ineffective code" and or an "effective code". Neither of these terms is readily understood. Although the specification alludes to a "null code" the examiner is not certain that such is indeed the "ineffective code". If such is the "ineffective code", then what is the "effective code"? Although no rejection based on insufficient disclosure is presented with at this time, absent a satisfactory explanation of the proper interpretation and support of such language, such a position can be presented in subsequent Office actions. Applicants' cooperation in further elaborating on such terminology is respectfully requested.

e) With respect to claims 30 and 31, applicant's attention is drawn to Ex parte Lyell, 17 USPQ2nd 1548. The examiner is not certain as to what limitation, product, apparatus or method these claims are drawn to.

e) Because none of the remaining dependent claims clarify the above deficiencies, they fall with their respective parent claim.

AS FAR AS THE CLAIMS RECITE POSITIVE LIMITATIONS, and as interpreted below, the following art rejections are made.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 2, 6, 10, 14, 18, 28- 31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over or Ikeda et al each further considered with Sims, III et al and Green Jr. et al..

Ikeda et al discloses an erasable optical disc system see figure 6 and its discussion, and in particular col. 12 lines 5 plus with respect to the ability of having "logical erasing".

The examiner also interprets column 3 lines 20 plus to disclose the TOC id information.

Although the format language with respect to frames is not present, such is considered to be inherent in the overall system of Ikeda et al. Furthermore, the last step of reserving particular frames having the id information is considered part and parcel of the erasing procedure in Ikeda et al.

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Alternatively, under 103 grounds, if applicant can convince the examiner that neither the frame format or the id reserving ability is not present in the above Ikeda et al system, then the examiner would rely upon the description found in Sims III et al with respect to frames, and Green Jr., et al with respect to the inability to erase (hence reserve) the disc identifier information.

It would have been obvious to one of ordinary skill in the art to modify the system of Ikeda et al with the teachings from both Sims, III et al and Green, Jr. et al, motivation is to use standard techniques/terminology with respect to frames and also to permit the ability to recognize disc identifier information related to manufacturing data for subsequent quality control issues/purposes.

b) With respect to claim 2, the examiner concludes the id information is in the leading segment of the TOC frame designation.

c) With respect to claims 10 and 14, the detection of the first and second frames – those containing the id information and the track address information is considered present in the Ikeda et al system.

d) With respect to claims 30 and 31, the examiner is interpreting these claims as methods. The method is considered present in the above system of Ikeda et al as stated above with respect to claim 1.

10. Claims 1,2,6,10,14, 18, 28 - 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Orange book standard – IEC –13490 (as described in Ooi et al) considered with Official notice with respect to personal computer systems having write abilities (writing drives).

The Orange book standard– IED –13490 as discussed in col. 1 lines 35 – 45 of Ooi et al discloses a cd-rw ability. Although the frame(s) format is not clearly depicted, the examiner again considers such as being inherently present in the Orange book standard as being standard nomenclature with respect to terms used in the art – see Sims, III et al for instance with respect to frames and kilobytes.

Although there is no mentioning of accessing, erasing and reserving, the existence of personal computers with write-able drives for recording is considered well known and Official notice is taken thereof.

Personal computers inherently require an operating system in which to perform any operation, and a standard in this field is MS-DOS , see the attached page 54 with respect to delete/erase .

no
need
Green, Jr.
et al.

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It would have been obvious to one of ordinary skill in the art to modify the system of a pc with the teaching from Ooi et al –re cd-rws & MS-DOS , motivation is to have reuseable records and hence permit updating and correction of errors of information recorded onto the medium. ✓

This operating system has the ability to “logically erase” information. The Orange book format is considered to inherently provide for TOC information having the required id information per disc. Upon deletion or erasing of “files” on a cd-rw medium in a pc, the examiner concludes that the steps outlined in the independent claims inherently are performed and hence meet the claimed limitations.

The limitations found in dependent claim 2 is considered inherently present in the Orange book format – id in a leading segment/section such as found in TOCs.

Again, claims 30 & 31 are interpreted as methods.

10. Claims 3, 7, 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1,5,10,14,& 18 above, and further in view of Official notice.

The limitation with respect to these claims centers on the ability of dividing sections into “ten number of frames”. The examiner considers such an ability as an obvious modification of the Orange book standard. That is, selection/designation that ten frames to contain the identification data of the disc is purely a design choice. At the very least the length of the identification area/segment/section is predicated on the amount of information and redundancy for errors one would like his system to contain. Hence, selecting ten frames for such is purely an optimization of system parameters, because a predefined amount of area must be set aside for the id information.

11. Claims 4,5,8,9,12,13,16,17,20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1,5,10, 14, 18 above, and further in view of Sims, III et al.

In interpreting the phrase “ineffective code” the examiner concludes such is a “null pattern” or “null data”. The ability of using null patterns/data in formatting of discs is taught by the Sim, III et al reference.

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Designating such as indicative of "ineffective data" is considered present in Sims, III et al, because data of all 0 (zero) values is inherently ineffective.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gushima et al is cited as illustrative of formats in this environment. Lee et al – see his description of figure 16 with respect to manufacturing data. Takeuchi et al – ability to have plurality of recording sessions to permit added information to be subsequently recorded. Sako – another examiner of disc id information present in the data of an optical disc. Tani – pca areas.

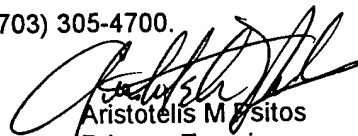
Allowable Subject Matter

13. Claims 22 and 25 would be allowable over the art of record if all noted 3 USC 112 rejections could be properly obviated. None of the cited prior art discloses or teaches the particular "five number of frames detection step and deletion step as presented therein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


Aristotelis M Psitos
Primary Examiner
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AMP
October 3, 2001